ATTACHMENT A

Remarks

In response to the Office Action mailed on January 24, 2007, reconsideration of the rejection of the claims is respectfully requested.

Claim Objections

Claims 1, 17 and 33 were objected to because the limitation "... determining an expiration date for said fee-based software ..." should allegedly be written as "... determining an expiration date of said fee-based software ..."

Claims 1, 17 and 33 have been amended as indicated even though it is respectfully submitted that there is no substantive difference between the phrases. Moreover, because this is a correction required by the Examiner, no new issues are raised by the amendment which would require further examination.

Claim Rejections – 35 U.S.C. 112

Claims 2, 18 and 34 have been rejected under 35 U.S.C. 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is alleged that there is insufficient antecedent basis for the limitation "the software of the user." This rejection is respectfully traversed. However, in an effort to resolve the outstanding issue, claims 2, 18 and 34 have been amended to address the rejection.

Claims 1, 17 and 33 recite "scanning a computer system of a user to detect fee-based software residing on said computer system of the user." Thus, "software residing on a computer system of a user" can logically be shortened to "software of a user" because if the computer system is "of a user" and software is resident on the computer system, then the software is also "of the user."

Nevertheless, as indicated, claims 2, 18 and 34 have been amended and now recite "the fee-based software." Again, it is submitted that there is no substantive difference between the pre-amendment claims and the post-amendment claims, so no

new issues are raised by the amendment that would require additional examination or searching.

Claim Rejections – 35 U.S.C. 103

Claims 1 – 3, 5 – 19, 21 – 35 and 37 – 48 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Sakata et al. (U.S. Patent Application Publication No. 2003/0033601) ("Sakata") in view of Cheng et al. (U.S. Patent No. 6,763,403) ("Cheng"). This rejection is respectfully traversed.

For convenience, claim 1 is reproduced below:

> 1. (Currently Amended) A method for offering alternative software, comprising:
>
> scanning a computer system of a user to detect fee-based software residing on said computer system of the user;
>
> determining an expiration date of said fee-based software residing on the computer system; and
>
> offering the user alternative software to the fee-based software based on the expiration date of the fee-based software.

The Office Action alleges that the Sakata reference discloses a method for offering alternative software, comprising: determining an expiration date for software residing on the computer system (e.g. Fig. 2, device 67 "expiration date checking device" and related text); and offering the user alternative software to the fee-based software based on the expiration date of the fee-based software (paragraph [0013] "... software is offered to the user by rental or lease agreement ..." and paragraph [0014] "... software is replaced with new software ...").

With respect to Fig. 2, the Sakata reference explains that expiration dates are set for each function of a broadcast reception terminal 60 (in the context of a pay-per-view broadcasting system (paragraph [0002])), including a remote controller 81 for activating a function of a remote controller, a channel switching device 82 for activating a channel switching function, a display screen setting device 83 for setting a size of a displayed screen, and a display power on/off device 84 for turning on/off a power supply of the display device. Respective function activation devices 80 check expiration dates of the functions monitored with an expiration date checking device 67 of the broadcast

reception terminal 60 (paragraph [0073]). Thus, the Sakata reference teaches checking expiration dates of functions (such as remote control, switch channels, set size of display screen, and power on/off) with an expiration date checking device of a broadcast reception terminal.

It is respectfully submitted that "checking expiration dates of functions of a broadcast reception terminal" cannot be equated to "determining an expiration date of fee-based software residing on a computer system," as recited in claim 1, because the functions of a broadcast reception terminal cannot be read as fee-based software residing on a computer system. In this regard, while the functions may be implemented by software, in the context of a pay-per-view system it is the functions themselves that expire, and not the software that implements them. Thus, the Sakata reference simply does not teach determining an expiration date for fee-based software residing on a computer system.

Further, it is respectfully submitted that the cited passages of the Sakata reference are mischaracterized with respect to the step of offering the user alternative software to the fee-based software based on the expiration date of the fee-based software, as recited in claim 1. While the Office action alleges that paragraph [0013] discloses that "... software is offered to the user ...," the actual disclosure is that a "set top box (STB) or the like with a short lifetime of software is offered to the user by a rental agreement or a lease agreement." Offering a "set top box having software" is not the same as offering "alternative software" because the set top box software is not alternative to any other software, much less the fee-based software residing on a computer system as recited in the claim.

Still further, cited paragraph [0014] recites, "Alternatively, in the case where the software of the leased information-based consumer electronics devices becomes outdated, it is necessary that this software is replaced with new software ...." It is respectfully submitted that "replacing outdated software" is also not the same thing as "offering alternative software to fee-based software based on the expiration date of the fee-based software" because the act inter alia of "replacing" is not the same as the act of "offering an alternative." Additionally, "outdated software" is not the same as "expired software." As discussed above, the Sakata reference discloses that the functions of the

set top box expire, and not the software. The Sakata reference observes that "information-based consumer electronic devices tend to have software with a shorter lifetime than that of the hardware. Therefore, after a passage of time, even if the hardware is in good condition, the user cannot be provided with a new service since the software is outdated." (paragraph [0012]) In this regard, it is clear that the "outdated" software still functions but merely prevents the user from being provided with "a new service." This is in contrast to "expired" software which, by definition, terminates or ceases to function all together after an expiration date. Thus, in the context of the teachings of the Sakata reference, "replacing outdated software" is clearly different than "offering alternative software to fee-based software based on the expiration date of the fee-based software," as recited in claim 1.

Even further, it is admitted in the Office Action that Sakata does not disclose scanning a computer system of a user to detect fee-based software residing on said computer system of the user and the Office Action cites the Cheng reference as disclosing analyzing a client computer to determine a list of installed software products.

It is not disputed that Cheng discloses analyzing a client computer to determine a list of installed software products. However, it is respectfully submitted that no reasonable basis is provided, nor does one appear to exist, as to why one of ordinary skill in the art would combine the set top box for a pay-per-view system of the Sakata reference with the teachings of the Cheng reference relating to analyzing a client computer to determine a list of installed software products. The set top box of the Sakata reference is not a client computer, as disclosed in Cheng, nor a computer system having fee-based software with expiration dates, as recited in claim 1. The Sakata reference discloses offering a set top box already having software to a user by a rental agreement (see paragraph [0013]). Presumably, a routineer practicing the teachings of the Sakata reference would know what software was on the set top box because the set top box is offered together with the software for operating it. The other cited teaching of Sakata regarding the software is that it is necessary to update outdated software in paragraph [0014]. However, there is no indication that there is any unknown software on the set top box that would require scanning or analysis to detect fee-based software residing on the set top box. Thus, there would be no motivation to

combine the Cheng reference with the Sakata reference because there is no need in the Sakata reference to scan the set top box to detect fee-based software residing thereon.

In summary, the combination of Sakata and Cheng does not teach or suggest the method of claim 1 because: 1) Sakata does not teach determining an expiration date of fee-based software residing on a computer system; 2) Sakata does not teach offering the user alternative software to the fee-based software based on the expiration date; and 3) Sakata and Cheng are not properly combinable to teach scanning a computer system of a user to detect fee-based software residing on the system. Thus, it is respectively submitted that claim 1 is allowable over the combination of Sakata and Cheng.

Independent claims 17 and 33 recite limitations that are equivalent to the limitations of claim 1, and the same rejections over the combination of Sakata and Chang were applied thereto. Thus, for the reasons set forth above, claims 17 and 33 are also allowable over the combination of Sakata and Cheng.

Further, claims 2, 3, 5 – 15, 18, 19, 21 – 31, 34, 35 and 37 -47 depend from independent claims 1, 17 and 33 and are allowable for at least the reasons provided in support of the allowability of the independent claims. Additionally, many of the dependent claims are separately patentable as discussed below.

Still further, independent claims 16, 32 and 48 recite equivalent limitations to claims 1 and 3, 17 and 19, and 33 and 35, respectively, and are also allowable for at least the reasons provided in support of the allowability of claims 1, 3, 17, 19, 33 and 35.

With respect to the separate patentability of dependent claim 2, claim 2 recites "transmitting a message to a software vendor at predetermined time intervals prior to the expiration date, wherein the software was not authored by the software vendor and is detected by a monitoring program.

It is suggested in the Office Action that the Sakata reference discloses transmitting a message to a software vendor at predetermined time intervals prior to the expiration date, in paragraph [0169].

Paragraph [0169] describes a means for obtaining the current date and transmitting this date to a security module. It is respectfully that the Sakata reference does not teach or suggest transmitting a message to a software vendor at predetermined time intervals prior to an expiration date, as recited in claim 2. Thus, claim 2, as well as claims 18 and 34 which contain equivalent limitations, are separately patentable over the combination of the Sakata and Cheng references.

Turning now to dependent claim 5, which recites after the offering step, providing the alternative software to the user in response to receiving an affirmative response from the user.

It is suggested in the Office Action that paragraph [0099] of the Sakata reference discloses the method of claim 5. However, paragraph [0099] of the Sakata reference discloses a log transmitting device that transmits data of a program which has been viewed and recorded data, such as a response to a questionnaire which the user has filled out, to the expiration date renewal server.

It is respectfully submitted that "transmitting a response to a questionnaire which a user has filled out to a server" cannot be equated to "providing alternative software to a user in response to receiving an affirmative response from a user," as recited in claim 5.

Thus, claim 5, and claims 21 and 37 which contain equivalent limitations, are separately patentable over the combination of the Sakata and Cheng references.

END REMARKS